

REMARKS

Claims 1-6 are pending.

The specification stands objected to for informalities.

Claims 1,3 stand objected to for informalities.

Claims 2,3 stand rejected for indefiniteness.

Claims 1,3,4,6 stand rejected for anticipation by McAleer.

Claim 5 stands rejected for obviousness v. McAleer in view of Official Notice.

Claims 1,3,4 are herein amended. Claim 2 is herein canceled.

In response to the Office Action:

Regarding the objections to the specification and claims for informalities:

The specification and claims 1,3 are herein amended to correct informalities in accordance with Examiner's suggestions.

Regarding the rejection of Claims 2,3 for indefiniteness:

The specification and Claim 2 are currently amended to clarify the term "bio-carbon" that was objected to. Bio-carbon was used in the original disclosure in a manner that is getting increased usage to designate an electrical element having a biological component, which in this case is carbon containing an enzyme. Examples of such terminology in general usage within the art would include "biosensor: A sensor which incorporates electronic and biological components to perform its function" [Wiley Electrical and Electronic Dictionary, John Wiley and Sons, 2004, page 72]; and "biochip: An IC which incorporates biological substances" [ibid, page 71].

As to basis, presence of the enzyme is explicitly disclosed in the original specification on page 5, line 3; and Applicant believes that the carbon is self-evident from both the above references in Wiley, and from Examiner's comments questioning whether carbon is a conductor.

With respect to whether carbon is a conductor: it is, although not necessarily having a low resistivity. An example would be a carbon-film resistor in which a carbon film is used as a controlled resistance element [Wiley, page 93].

Claim 3 is herein amended to incorporate Examiner's suggested change in terminology.

Reconsideration of the objection is respectfully requested.

Regarding the rejection of claims 1,3,4,6 for anticipation by McAleer:

Applicant has carefully considered the Office Action, and respectfully traverses Examiner's arguments that claims 1,3,4,6 of the instant invention are anticipated by McAleer, for several reasons which the claims have been amended to clarify.

Claim 1 is currently amended to incorporate limitations of the previous claims 2,4 and to clarify differences between this application and the cited references so as to put the claims in condition for allowance.

Anticipation requires that the cited reference contain *all* of the elements and limitations of the instant invention. Applicant respectfully submits that McAleer lacks several elements and/or limitations present in currently amended claims of the instant invention. For example, the amended base claim 1 of the instant invention includes a test strip having:

a protruding guide portion adapted to pick up the liquid test sample to be examined
and to guide the received liquid test sample to a test sample space;
a circuit pattern on said strip of substrate formed of bio-carbon composed
of a carbon containing an enzyme for reacting with the particular
liquid test sample being tested.

McAleer discloses neither of these elements:

the test strip of McAleer has *no* protruding guide portion.

Further, McAleer does not disclose a *circuit pattern of bio-carbon* as in the instant invention, having instead a *multi-layer structure* with an insulating layer 18 on top of a carbon layer 14 forming one electrode, and a separation layer 17, composed of silica containing an enzyme, on top of a carbon layer 16 forming the second electrode.

Applicant respectfully submits that McAleer does not contain all of the elements and limitations of the amended claim 1 of the instant invention, and does not meet the threshold requirements for anticipation rejection of claim 1.

Of course if the base claim is not anticipated, then the dependent claims cannot be anticipated.

Reconsideration of the anticipation rejection is respectfully requested.

Regarding the rejection of claim 5 for obviousness v. McAleer in view of ?:

Obviousness rejection requires that the cited references, in combination, contain *all* of the elements and limitations of the instant invention. In addition there must be a “clear and particular” suggestion to combine the references in a manner that would produce the instant invention.

First, Applicant is compelled to note Examiner’s admission that McAleer does not have the front probe geometry of claim 5 of the instant invention, however, no other reference is cited cover this deficiency. In addition, as noted above, McAleer does not have certain other elements of the base claim and cannot therefore support an obviousness rejection alone.

Applicant respectfully requests identification of the source of information that is to be used in combination with McAleer in establishing obviousness. If that source is personal knowledge of the Examiner, or a form of Official Notice then a formal affidavit is requested.

In addition, the suggestion to combine must come from the prior art. In the present case the Examiner has cited an incentive which appears to originate from within the

instant application itself. Further, merely citing a potential benefit does not constitute an adequate suggestion to combine in a manner that would produce the instant invention.

Applicant respectfully submits that the case presented for obviousness, built around McAleer, does not meet the threshold requirements for an obviousness rejection.

Reconsideration of the obviousness rejection of is respectfully requested.

Applicant believes that this amendment answers all instances in which the Examiner rejected or objected, and that the amendment places all remaining claims in condition for allowance.

CONCLUSION

In view of the foregoing, Applicant believes all claims now pending in this application are in condition for issue. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at (408) 358-0489.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'R. Willgohs', with a long horizontal flourish extending to the right.

Ralph H. Willgohs

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